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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,831	07/11/2001	Thomas J. Maginot	22220-06167	1578
758 7590 08/29/2008 FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041				
EXAMINER				
PREBILIC, PAUL B				
ART UNIT		PAPER NUMBER		
3774				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/903,831

Applicant(s)

MAGINOT, THOMAS J.

Examiner

Paul B. Prebille

Art Unit

3774

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) See Continuation Sheet is/are allowed.
- 6) ☒ Claim(s) 70, 71, 121-123, 125, 127, 129, 131, 132, 134, 136-139, 152 and 433 is/are rejected.
- 7) ☒ Claim(s) 130 and 133 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Final Drawing (PTO-640)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/4/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 70,71,75-78,80-82,84-86,90-94,101,102,104,106,107,109,121-123,125,127,129-134,136-140,142,143,152,153,159,164-166,426,427,433,434 and 436.

Continuation of Disposition of Claims: Claims allowed are 75-78,80-82,84-86,90-94,101,102,104,106,107,109,140,142,143,153,159,164-166,426,427,434 and 436.

37 CFR 1.105 REQUIREMENT FOR INFORMATION

Applicant (or the assignee of this application if the assignee has undertaken the prosecution of the application) is required under **37 CFR 1.105** to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

There are numerous other co-pending applications and issued patents, which disclose and claim very similar and/or identical subject matter. In accordance with **37 CFR 1.105** and **MPEP 704.11(a) subsection G**, applicant (or the assignee) is respectfully requested to disclose all co-pending applications and related patents (please see the non-exhaustive list below of applications and issued patents that the USPTO believes may be related) and identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims. This requirement is reasonably necessary to examination because, based on an initial review of the applications, there is a significant degree of overlap in claimed subject matter, thus requiring an analysis of commonality of claimed subject matter to determine patentability under 35 USC 101 double patenting and/or obviousness type double patenting. For example, the method of claim 1 in copending application 11/440,267 is also drawn to a method of forming an anastomosis between the conduit and the side wall of a blood vessel as set forth in claim 70 of the present application such that the difference between the two claims is clearly obvious. Claim 70 of the present application is read on by claim 11 of US Patent 5,304,220 such that the present claims appears clearly obvious in view thereof. Similarly, claim 70 of the present

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application appears to be read on by claims 17, 18, 20, 21, 22, 26, 28, and 29 of US Patent 5,211,683.

Because the applicant (or the assignee) is presumably far more cognizant of the contents of the claims in these applications than any Office staff, and has access to the source documents by which such comparison could be done better than within the Office, it is reasonable to require the applicant to provide the information needed to determine the commonality among the claims.

Should applicant (or the assignee) believe that Double Patenting exists, than applicant (or the assignee) is invited to file Terminal Disclaimers and/or amend the currently pending claims in the interest of expediting the prosecution of the current application. Applicant (or the assignee) should note that a terminal disclaimer is effective to overcome an obviousness type double patenting rejection, but will not overcome a "same type" double patenting rejection under 35 U.S.C. § 101.

A Non-exhaustive list of possible related co-pending applications and patents:

USSN 11/440,267

USSN 11/264,929

USSN 10/731,068

USSN 11/375,387

USSN 11/673,053

US 7,100,617

US 5,571,167

US 5,934,286

US 7,033,383

US 6,401,721

US 6,599,313

US 5,304,220

US 5,749,375

US 5,211,683

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US 5,979,455

US 6,401,721

US 5,456,712

This requirement is normally subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months, but since this Request is also being done in conjunction with a non-final Office action, the shortened statutory period is 3 months. Extensions of this time period may be granted under 37 CFR 1.136(a).

Claim Objections

Claim 127 is objected to because of the following informalities: the "positioning step" lacks clear antecedent basis from base claim 121. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 433 is rejected under 35 U.S.C. 102(e) as being anticipated by Kaster (US 4,366,462). Kaster anticipates the claim language where the blood flow conduit as claimed is the blood vessel (51) of Kaster, the sidewall as claimed is the hole (52) of

Kaster in the second blood vessel (53), and the flange as claimed is any one or a plurality of the interior wall engaging members (43) since a flange can be "a rib or rim for strength, for guiding, or for attachment to another object" (Merriam-Webster Online at <http://www.merriam-webster.com/cgi-bin/dictionary?book=Dictionary&va=flange>. Each member (43) is a rib to the extent claimed so the claim language is fully met; see Figures 16 to 19 and column 6, line 39 to column 7, line 14 where the rib or flange is shown extending radially about the orifice.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 70, 71, 121-123, 125, 127, 129, 131, 132, 134, 136, 137, 138, 139, and 152 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaster et al (US 4,366,462) in view of Donaldson (US 2,935,068). Kaster teaches end-to-side anastomosis with arms (fingers (26)) and a flange (band (46)). But Kaster discloses the method of blood vessel by-pass in general and not for the use on an artery or aorta; see portions of Kaster cited in the Section 102 rejection *supra*. However, Donaldson teaches that it was known to use similar devices to by-pass aortas; see Figure 3 and column 1. The concept of attaching a conduit to a blood vessel sidewall (i.e. generic to artery or aorta) was known at the time the invention was made. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to utilize the Kaster

method and device in a method of aorta by-pass for the same reasons that Donaldson teaches doing the same.

With regard to claim 121, the strut assembly is that of the members (43).

With regard to claim 129, the flange is that of member(s) (43) of Kaster.

Allowable Subject Matter

Claims 75-78, 80-82, 84-86, 90-94, 101, 102, 104, 106, 107, 109, 140, 142, 143, 153, 159, 164, 165, 166, 426-427, 434, and 436 are allowable over the prior art of record.

Claims 130 and 133 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Preblich whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Frederick R Schmidt/
Director, Technology Center

/Paul Prebilic/
Paul Prebilic
Primary Examiner
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